REMARKS

Claim Rejections

Claims 7-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable by Tack (U.S. 2,345,017) in view of Stehle (U.S. 3,809,192).

It is noted that the references to Tack and Stehle were initially cited by the Examiner in the outstanding Final Office Action. Thus, this Amendment represents Applicant's initial opportunity to respond to the rejections based upon these references.

Drawings

It is noted that the Examiner has accepted the drawings filed on March 7, 2005.

Claim Amendments

By this Amendment, Applicant has amended claim 7 of this application. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The primary reference to Tack teaches a rotor having annular plates (16, 18), a plate-like portion (10) located between the annular plates, and a plurality of blades (20).

Tack does not teach a plurality of heat sink holes located through each of the first brake surface, the second brake surface, and the heat sink; nor does Tack teach a predetermined number of the plurality of heat sink holes form a plurality of curved patterns in each of the first brake surface, the second brake surface, and the heat sink.

The secondary reference to Stehle teaches a dick brake having two parallel disk-shaped parts (9, 10) having a plurality of recesses (14).

Stehle does not teach a plurality of heat sink holes located through each of the first brake surface, the second brake surface, and the heat sink; nor does Stehle teach a predetermined number of the plurality of heat sink holes form a plurality of curved patterns in each of the first brake surface, the second brake surface, and the heat sink.

Even if the teachings of Tack and Stehle were combined, as suggested by the Examiner, the resultant combination does not suggest: a plurality of heat sink holes located through each of the first brake surface, the second brake surface, and the heat sink; nor does the combination suggest a predetermined number of the plurality of heat sink holes form a plurality of curved patterns in each of the first brake surface, the second brake surface, and the heat sink.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

> The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

> As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

> We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Tack or Stehle that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Tack nor Stehle disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.

Summary

In view of the foregoing, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should the Examiner not be of the opinion that this case is in condition for allowance, it is requested that this amendment be entered for the purposes of appeal.

Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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